

APR 30 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Patent Application of

Mutsuyoshi ITO

Art Unit: 2827

Serial No. 09/898,068

Examiner: D. Graybill

Filed: July 5, 2001

For: SEMICONDUCTOR PACKAGE AND METHOD FOR PRODUCING THE SAME

**PETITION UNDER 37 C.F.R. §1.144**

**BOX AF**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is a petition under 37 C.F.R. §1.144 requesting review of a restriction requirement made by the Examiner in the Office Action mailed on December 18, 2002.

The restriction requirement of December 18, 2002 asserts an existence of the following independent and distinct inventions:

Group I, having claims 2, 4 and 9-14, drawn to a product allegedly classified in class 257, subclass 690;

Group II, having claims 7, 8 and 15-20, drawn to a process allegedly classified in class 438, subclass 106.

A request for reconsideration of the restriction requirement was filed on January 21, 2003 within a Response to Restriction

Requirement. That Response elected with traverse the examination of the Group I invention, having claims 2, 4 and 9-14.

In response to the election and traversal made within the Response to Restriction Requirement, the Final Office Action mailed on April 7, 2003 maintained the restriction requirement, making it FINAL.

Accordingly, this petition pursuant to 37 C.F.R. §1.144 is proper.

For the reasons provided hereinbelow, the restriction requirement made within the Office Action mailed on December 18, 2002 is respectfully traversed.

The Office Action of December 18, 2002 indicates that restriction is proper because claims 2, 4, 9-14 are drawn to a product and claims 7, 8, 15-20 are drawn to a process.

Applicant traverses the Restriction Requirement for the following reasons.

"Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered." M.P.E.P. §803.01.

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. §803, 8<sup>th</sup> Edition, August 2001.

The Office Action of April 7, 2003 contends that restriction is proper at any stage during the prosecution up to final action. M.P.E.P. §811.02(a), 8<sup>th</sup> Edition, August 2001.

In response to the contention, please note that the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application. M.P.E.P. §818.02(a), 8<sup>th</sup> Edition, August 2001.

The Office Action of June 24, 2002 included an examination of claims 1-8 on the merits. Thus, the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application. M.P.E.P. §818.02(a).

In this regard, claims 1-8 were originally filed with the original specification, with claims 1-4 being drawn to a product and claims 5-8 being drawn to a method. The product embodied by

the originally filed claims 1-4 and the method embodied by the originally filed claims 5-8 were previously acted upon on merits within the Office Action of June 24, 2002.

The amendment filed on September 24, 2002 canceled claims 1 and 3, placed originally filed claims 2 and 4 into independent form, and added claims 9-14. Thus, currently existing claims 2 and 4 were previously acted upon on merits within the Office Action of June 24, 2002 as originally filed claims 2 and 4.

Claims 9-11 are dependent upon the product of originally filed claim 2, claims 12-14 are dependent upon the product of originally filed claim 4.

The amendment filed on September 24, 2002 canceled claims 5 and 6, placed originally filed claims 7 and 8 into independent form, and added claims 15-20. Thus, currently existing claims 7 and 8 were previously acted upon on merits within the Office Action of June 24, 2002 as originally filed claims 7 and 8.

Claims 15-17 are dependent upon the method of originally filed claim 7, and claims 18-20 are dependent upon the product of originally filed claim 8.

While originally filed claims 2, 4, 7 and 8 have been

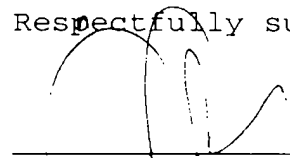
previously examined on the merits, the Office Action of December 18, 2002 seeks to make a restriction among claimed features that have already by searched, examined and rejected.

Because, the product and method embodied by the originally filed claims 1-8, and currently embodied within 2, 4 and 7-20 have been previously acted upon on merits within the Office Action of June 24, 2002, the restriction requirement made within the Office Action of December 18, 2002 is respectfully traversed as improper.

Applicant requests that the Commissioner exercise his supervisory authority under 37 C.F.R. §1.144 and withdraw this improper restriction requirement.

No fee is believed to be required in connection with this petition. However, if any fee is required, authorization is given to charge Deposit Account 18-0013.

Respectfully submitted,

  
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Ronald P. Kananen  
Reg. No. 24,104

DATE: April 30, 2003

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